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Paper No. 17

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In re Application of
Gary E. Johnson
Application No. 09/204,866
Filed: December 3, 1998
Attorney Docket No. PA1.615
Title: POWERED CUTTING SURFACE
WITH PROTECTIVE GUARD FOR
EQUINE TEETH

DECISION DISMISSING
PETITION UNDER 37 C.F.R. §1.137(b)

This is a decision on the petition filed on March 24, 2003, pursuant to 37 C.F.R. §1.137(b)¹, to revive the above-identified application.

The above-identified application became abandoned for failure to reply within the meaning of 37 C.F.R. §1.113 in a timely manner to the final Office action mailed June 12, 2002, which set a shortened statutory period for reply of three (3) months. On September 12, 2002, an amendment was received. The amendment was considered by the Examiner, and was not deemed to place the application in condition for allowance. An advisory action was mailed on October 15, 2002, which did not grant any additional period for response. On December 23, 2002, a second after-final amendment was received, containing a certificate of mailing dated December 21, 2002. On January 24, 2003, a notice of abandonment was mailed, which indicated that applicant's submission could not be considered, since it was filed subsequent to the maximum extendable period for response (December 12, 2002). Accordingly, the above-identified application became abandoned on September 13, 2002.

¹ A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in § 1.17(m);
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional, and;
- (4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

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With this petition, the petitioner paid the petition fee, made the proper statement of unintentional delay, submitted an amendment, and submitted the fee associated with the filing of a statutory disclaimer².

Petitioner has also submitted a five-month extension of time (three months for the response to the final action which was received subsequent to the maximum extendable period for response, and two months for the filing of this petition). Regarding the three-month extension of time, this would have been necessary only if the amendment had been filed after the maximum extendable period for response. Regarding the two-month extension of time, an extension of time under 37 C.F.R. §1.136 must be filed prior to the expiration of the maximum extendable period for reply³. Accordingly, since the \$ 985.00 extension of time submitted with the petition on March 24, 2003 was subsequent to the maximum extendable period for reply, this fee is unnecessary and will be credited to petitioner's deposit account.

The instant petition is not grantable because requirement (1) above has not been satisfied.

The petition under 37 C.F.R. §1.137(b) is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)."

It is clear from rule 37 C.F.R. §1.116 that abandonment of an application is risked when the applicant proffers an amendment after the mailing of a final Office action. The rule clearly indicates that the mere filing of an amendment does not relieve applicant of the duty to take appropriate action to save the application from abandonment.

If steps are not taken after final to maintain pendency prior to the expiration of the maximum extendable period for reply, the application will go abandoned. Put another way, the submission of an after final amendment which fails to place the application in condition for allowance will result in the abandonment of the application, unless one of the following four items is filed prior to the maximum extendable period for reply:

- a subsequent amendment which places the application in condition for allowance;
- a Notice of Appeal;
- a Request for a Continuation Application pursuant to 37 C.F.R. § 1.53(b), if applicable;
- a Request for Continued Examination pursuant to 37 C.F.R. §1.114, and;
- a Terminal Disclaimer, if applicable.

² As this application was filed subsequent to June 8, 1995, no terminal disclaimer is necessary. As such, the associated fee has not been charged to Petitioner's deposit Account.

³ See In re Application of S., 8 USPQ2d 1630, 1631 (Comm'r Pats. 1988).

Petitioner did not submit the required reply to the Office action. The required reply is the reply sufficient to have avoided abandonment, had such reply been timely filed⁴. In order for the application to be revived, petitioner must submit a reply which satisfies 37 C.F.R. §1.137(b)(1) (i.e., a Notice of Appeal (and fee required by law); an amendment that *prima facie* places the application in condition for allowance; a continuing application under 37 C.F.R. §1.53(b); a request for continuing examination under 37 C.F.R. §1.114, if applicable; or a 37 C.F.R. §1.129(a) submission, if applicable). The amendment which was filed concurrently with the instant petition has been considered by the Examiner, but it failed to place the application in condition for allowance. A courtesy copy of the advisory action prepared in response to this amendment has been included.

In order for the petition under 37 C.F.R. §1.137(b) to be granted, the petitioner must submit the required reply, which consists of an amendment which places the application in condition for allowance, the filing of a notice of appeal, or the filing of either a Continuing Application or a Request for Continued Examination.

The reply to this letter may be submitted by mail⁵, hand-delivery⁶, or facsimile⁷.

The application file will be retained in the Office of Petitions for two (2) months.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (703) 305-0011.



Paul Shanowski
Attorney
Office of Petitions
United States Patent and Trademark Office

⁴ See M.P.E.P. 711.03(c).

⁵ Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1460, Alexandria, VA 22313-1460. Note that this is a new address, as the USPTO has changed addresses as of May 1, 2003.

⁶ Office of Petitions, 2201 South Clark Place, Crystal Plaza 4, Suite 3C23, Arlington, VA 22202.

⁷ (703) 308-6916, Attn: Office of Petitions.

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